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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,849	09/25/2003	Rahul L. Shah	5681-69900	1386

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EXAMINER

NAUROT TON, JOAN

ART UNIT	PAPER NUMBER
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2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/01/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/670,849

Applicant(s)

SHAH, RAHUL L.

Examiner

Joan B. Naurot Ton

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2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/11/2005 and 06/02/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This first office action is in reply to the Application filed on September 25, 2003,

Application number 10/670849 by Rahul Shah;

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 8, 17, 27, 36, 46, and 55 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 13, 14, 27, 28, 41, and 42, respectively of copending US Application No.10/670550. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding claim 8 of US application number 10/670849 vs. claim 13 of US application number 10/670550, claim 17 of US application number 10/670849 vs. claim 14 of US application number 10/670550, claim 27 of US application number 10/670849 vs. claim 27 of US application number 10/670550, claim 36 of US application number 10/670849 vs. claim 28 of US application number 10/670550, claim 8 of US application number 10/670849 vs. claim 13 of US application number 10/670550, claim 46 of US

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application number 10/670849 vs. claim 41 of US application number 10/670550, and claim 55 of US application number 10/670849 vs. claim 42 of US application number 10/670550, the scope of the above respective claims is the same. The elements are merely presented in a different order. However, as nothing in either claim mandates a particular order, the examiner asserts that this presentation of elements does not create a patentable difference.

3. Claims 9, 18, 28, and 37 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 9, 10, 19, and 20, respectively of copending Application No. 10/670549. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Regarding claim 9 of US Application number 10/670849 vs. claim 9 of US Application number 10/670549, claim 18 of US Application number 10/670849 vs. claim 10 of US Application number 10/670549, claim 28 of US Application number 10/670849 vs. claim 19 of US Application number 10/670549, and claim 37 of US Application number 10/670849 vs. claim 20 of US Application number 10/670549, the scope of the above respective claims is the same. The elements are merely presented in a different order. However, as nothing in either claim mandates a particular order, the examiner asserts that this presentation of elements does not create a patentable difference.

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory

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obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 11, 20, 30, 39, and 49 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13, 14, 27, 28, 41, and 42, respectively of copending Application No. 10/670550. Although the conflicting claims are not identical, they are not patentably distinct from each other because of extra limitations included in Application number 10/670550 which can be excluded in order to meet the limitations of Application number 10/670849.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of US Application number 10/670849 vs. claim 13 of US Application number 10/670550: Claim 1 of US Application number 10/670849 discloses a method, comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in

response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining. (Claim 13 of 10/670550 discloses the method as recited in claim 1, further comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining said presence state of said instant messenger in response to receiving said instant messaging operation; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining.)

Claim 13 of US Application number 10/670550 teaches all the limitations of claim 1 of US Application number 10/670849 except that claim 13 of US Application number 10/670550 includes the limitations of claim 1 of 10/670550.

Regarding excluding the limitations of claim 1 of Application number 10/670550 from claim 13 of US Application number 10/670550, in order to meet the limitations of claim 1 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 1 of 10/670550 from claim 13 of 10/670550, as an obvious mechanical expedient, as removing parts from a method is well known in the art, in order to simplify the design.

Claim 11 of US Application number 10/670849 vs. claim 14 of US Application number 10/670550: Claim 11 of 10/670849 discloses a method, comprising: storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user; detecting a

transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting. (Claim 14 of 10/670550 discloses the method as recited in claim 1, further comprising: storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to a given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.

Claim 14 of US Application number 10/670550 teaches all the limitations of claim 11 of US Application number 10/670849 except that claim 14 of US Application number 10/670550 includes the limitations of claim 1 of 10/670550.

Regarding excluding the limitations of claim 1 of Application number 10/670550 from claim 14 of US Application number 10/670550, in order to meet the limitations of claim 11 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 1 of 10/670550 from claim 14 of 10/670550, as an obvious mechanical expedient, as removing parts from a method is well known in the art, in order to simplify the design.

Claim 20 of US Application number 10/670849 vs. claim 27 of US Application number 10/670550: Claim 20 of 10/670849 discloses a computer-accessible medium comprising program instructions, the program instructions are computer-executable to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to

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said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Claim 27 of 10/670550 discloses the computer-accessible medium as recited in claim 15, wherein said program instructions are further computer-executable to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine said presence state of said instant messenger in response to receiving said instant messaging operation; and selectively process said instant messaging operation dependent upon said presence state in response to said determining.)

Claim 27 of US Application number 10/670550 teaches all the limitations of claim 20 of US Application number 10/670849 except that claim 27 of US Application number 10/670550 includes the limitations of claim 15 of 10/670550.

Regarding excluding the limitations of claim 15 of Application number 10/670550 from claim 27 of US Application number 10/670550, in order to meet the limitations of claim 20 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 15 of 10/670550 from claim 27 of 10/670550, as an obvious mechanical expedient, as removing parts from a program is well known in the art, in order to simplify the design.

Claim 30 of US Application number 10/670849 vs. claim 28 of US Application number 10/670550: Claim 30 of 10/670849 discloses a computer-accessible medium comprising program instructions, wherein the program instructions are computer-executable to: store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a

given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (Claim 28 of 10/670550 discloses the computer-accessible medium as recited in claim 15, wherein said program instructions are further computer-executable to: store an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting.)

Claim 28 of US Application number 10/670550 teaches all the limitations of claim 30 of US Application number 10/670849 except that claim 28 of US Application number 10/670550 includes the limitations of claim 15 of 10/670550.

Regarding excluding the limitations of claim 15 of Application number 10/670550 from claim 28 of US Application number 10/670550, in order to meet the limitations of claim 30 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 15 of 10/670550 from claim 28 of 10/670550, as an obvious mechanical expedient, as removing parts from a program is well known in the art, in order to simplify the design.

Claim 39 of US Application number 10/670849 vs. claim 41 of US Application number 10/670550: Claim 39 of 10/670849 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given

user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Claim 41 of 10/670550 discloses the system as recited in claim 29, wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine said presence state of said instant messenger software module in response to receiving said instant messaging operation; and selectively process said instant messaging operation dependent upon said presence state in response to said determining.)

Claim 41 of US Application number 10/670550 teaches all the limitations of claim 39 of US Application number 10/670849 except that claim 39 of US Application number 10/670550 includes the limitations of claim 29 of 10/670550.

Regarding excluding the limitations of claim 29 of Application number 10/670550 from claim 41 of US Application number 10/670550, in order to meet the limitations of claim 39 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 29 of 10/670550 from claim 41 of 10/670550, as an obvious mechanical expedient, as removing parts from a system is well known in the art, in order to simplify the design.

Claim 49 of US Application number 10/670849 vs. claim 42 of US Application number 10/670550: Claim 49 of 10/670849 discloses a system, comprising: a computer

system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (Claim 42 of 10/670550 discloses the system as recited in claim 29, wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting.)

Claim 42 of US Application number 10/670550 teaches all the limitations of claim 49 of US Application number 10/670849 except that claim 42 of US Application number 10/670550 includes the limitations of claim 29 of 10/670550.

Regarding excluding the limitations of claim 29 of Application number 10/670550 from claim 42 of US Application number 10/670550, in order to meet the limitations of claim 49 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 29 of 10/670550 from claim 42 of 10/670550, as an obvious mechanical expedient, as removing parts from a system is well known in the art, in order to simplify the design.

3. Claims 1, 11, 20, 30, 39, 47, 49, and 56 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 10, 19, 20, 29, 29, 30, and 30, respectively of copending US Application No. 10670549. Although the conflicting claims are not identical, they are not patentably distinct from each other because of extra limitations included in Application number 10/670549 which can be excluded in order to meet the limitations of Application number 10/670849.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim 1 of US Application number 10/670849 vs. claim 13 of US Application number 10/670549: Claim 1 of 10/670849 discloses a method, comprising receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining. (Claim 9 of 10/670549 discloses the method as recited in claim 1, further comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of said instant messenger in response to receiving said instant messaging operation; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining.)

Claim 9 of US Application number 10/670549 teaches all the limitations of claim 1 of US Application number 10/670849 except that claim 9 of US Application number 10/670549 includes the limitations of claim 1 of 10/670549.

Regarding excluding the limitations of claim 1 of Application number 10/670549 from claim 9 of US Application number 10/670549, in order to meet the limitations of claim 1 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 1 of 10/670549 from claim 9 of 10/670549, as an obvious mechanical expedient, as removing parts from a method is well known in the art, in order to simplify the design.

Claim 11 of US Application number 10/670849 vs. claim 10 of US Application number 10/670549: Claim 11 of US Application number 10/670849 discloses a method, comprising: storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting. (Claim 10 of US Application number 10/670549 discloses the method as recited in claim 1, further comprising: storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to a given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.)

Claim 10 of US Application number 10/670549 teaches all the limitations of claim 11 of US Application number 10/670849 except that claim 10 of US Application number 10/670549 includes the limitations of claim 1 of 10/670549.

Regarding excluding the limitations of claim 1 of Application number 10/670549 from claim 11 of US Application number 10/670549, in order to meet the limitations of claim 11 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 1 of 10/670549 from claim 10 of 10/670549, as an obvious mechanical expedient, as removing parts from a method is well known in the art, in order to simplify the design.

Claim 20 of US Application number 10/670849 vs. claim 19 of US Application number 10/670549: Claim 20 of 10/670849 discloses a computer-accessible medium comprising program instructions, wherein the program instructions are computer-executable to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Claim 19 of 10/670549 discloses the computer-accessible medium as recited in claim 11, wherein said program instructions are further computer-executable to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger in response to receiving said

instant messaging operation; and selectively process said instant messaging operation dependent upon said presence state in response to said determining.)

Claim 19 of US Application number 10/670549 teaches all the limitations of claim 20 of US Application number 10/670849 except that claim 19 of US Application number 10/670549 includes the limitations of claim 11 of 10/670549.

Regarding excluding the limitations of claim 11 of Application number 10/670549 from claim 19 of US Application number 10/670549, in order to meet the limitations of claim 20 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 11 of 10/670549 from claim 19 of 10/670549, as an obvious mechanical expedient, as removing parts from a method is well known in the art, in order to simplify the design.

Claim 30 of US Application number 10/670849 vs. claim 20 of US Application number 10/670549: Claim 30 of 10/670849 discloses a computer-accessible medium comprising program instructions, wherein the program instructions are computer-executable to: store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (Claim 20 of 10/670549 discloses the computer-accessible medium as recited in claim 11, wherein the program instructions are computer-executable to: store an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to a given user; detect a transition to said given

presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting.)

Claim 20 of US Application number 10/670549 teaches all the limitations of claim 30 of US Application number 10/670849 except that claim 20 of US Application number 10/670549 includes the limitations of claim 11 of 10/670549.

Regarding excluding the limitations of claim 11 of Application number 10/670549 from claim 20 of US Application number 10/670549, in order to meet the limitations of claim 30 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 11 of 10/670549 from claim 20 of 10/670549, as an obvious mechanical expedient, as removing parts from a program is well known in the art, in order to simplify the design.

Claim 39 of US Application number 10/670849 vs. claim 29 of US Application number 10/670549: Claim 39 of 10/670849 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Claim 29 of 10/670549 discloses the system as recited in claim 21, wherein said instant messenger software module is further configured to: receive an

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instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation; and selectively process said instant messaging operation dependent upon said presence state in response to said determining.)

Claim 29 of US Application number 10/670549 teaches all the limitations of claim 39 of US Application number 10/670849 except that claim 29 of US Application number 10/670549 includes the limitations of claim 21 of 10/670549.

Regarding excluding the limitations of claim 21 of Application number 10/670549 from claim 29 of US Application number 10/670549, in order to meet the limitations of claim 39 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of claim 21 of 10/670549 from claim 29 of 10/670549, as an obvious mechanical expedient, as removing parts from a system is well known in the art, in order to simplify the design.

Claim 47 of US Application number 10/670849 vs. claim 29 of US Application number 10/670549: Claim 47 of 10/670849 discloses the system as recited in claim 39, wherein said instant messenger software module is further configured to: store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; query said schedule information; and if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in

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response to said querying, wherein said current presence state and said different presence state each correspond to said given user. Claim 39 of 10/670849 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Claim 29 discloses the system as recited in claim 21, wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. Claim 21 depends on claim 29, and claim 21 of 10/670549 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; and a calendar application software module configured to store schedule information corresponding to a given user, wherein said schedule information is indicative of an activity status of said given user at a given time, and further configured to respond to queries of said schedule information from said instant messenger software module; wherein said instant messenger software

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module is further configured to: query said schedule information; and if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.)

Claim 29 of US Application number 10/670549 teaches all the limitations of claim 47 of US Application number 10/670849 except that claim 29 of US Application number 10/670549 includes the limitations of the calendar software module of claim 21 of 10/670549. The elements of the claims are also presented in a different order. However, as nothing in either claim mandates a particular order, the examiner asserts that this presentation of elements is an obvious design choice.

Regarding excluding the limitations of a calendar application software module of Application number 10/670549 from claim 21 of US Application number 10/670549, in order to meet the limitations of claim 47 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the limitations of a calendar application software module of 10/670549 from claim 21 of 10/670549, as an obvious mechanical expedient, as removing parts from a system is well known in the art, in order to simplify the design.

Claim 49 of US Application number 10/670849 vs. claim 30 of US Application number 10/670549: Claim 49 of 10/670849 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said

computer system; wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (Claim 30 of 10/670549 discloses the system as recited in claim 21, wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting.)

Claim 30 of US Application number 10/670549 teaches all the limitations of claim 49 of US Application number 10/670849 except that claim 30 of US Application number 10/670549 includes the limitations of claim 21 of 10/670549.

Regarding excluding the some of the limitations of the calendar software module in claim 21 and performing extra configurations listed in claim 21 of Application number 10/670549 from claim 30 of US Application number 10/670549, in order to meet the limitations of claim 49 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to exclude some of the limitations of claim 21 of 10/670549 from claim 9 of 10/670549, as an obvious mechanical expedient, as removing parts from a system is well known in the art, in order to simplify the design.

Claim 56 of US Application number 10/670849 vs. claim 30 of US Application number 10/670549: Claim 56 of 10/670849 discloses the system as recited in claim 49, wherein said instant messenger software module is further configured to: store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; query said schedule information; and if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. Claim 49 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to Said detecting. (Claim 30 of US Application number 10/670549 discloses the system as recited in claim 21, wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. Claim 21

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discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; and a calendar application software module configured to store schedule information corresponding to a given user, wherein said schedule information is indicative of an activity status of said given user at a given time, and further configured to respond to queries of said schedule information from said instant messenger software module; wherein said instant messenger software module is further configured to: query said schedule information; and if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user.) The elements of the claims are also presented in a different order. However, as nothing in either claim mandates a particular order, the examiner asserts that this presentation of elements is an obvious design choice.

Claim 30 of US Application number 10/670549 teaches all the limitations of claim 56 of US Application number 10/670849 except that claim 30 of US Application number 10/670549 includes the limitations of the calendar software module in claim 21 of 10/670549.

Regarding excluding the limitations of a calendar software module in claim 21 of Application number 10/670549 from claim 30 of US Application number 10/670549, in order to meet the limitations of claim 56 of US Application number 10/670849, it would have been obvious to one of ordinary skill in the art at the time of the invention to

exclude the limitations of a calendar software module in claim 21 of 10/670549 from claim 30 of 10/670549, as an obvious mechanical expedient, as removing parts from a system is well known in the art, in order to simplify the design.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 8, 9, 17, 18, 19, 20, 27, 28, 36, 37, 38, 39, 46, 47, 55, 56, and 57 are rejected because the claimed invention is directed to non-statutory subject matter: a process with no tangible output results.

Claim 1 is drawn to an instant messaging method which determines a presence state and selectively processes an instant messaging operation. Determining and processing in this case does not produce a tangible output result as the result is not displayed to an output device.

In similar fashion, the following claims are also rejected:

In claim 8, "detecting", "determining" and "transitioning" do not produce a tangible output result.

In claims 9 and 17, "assigning" does not produce a tangible output result. In addition, in claim 17, "determining" does not produce a tangible output result.

In claim 18, "assigning" does not produce a tangible output result.

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In claim 19, "determining" and "processing" does not produce a tangible output result.

In claim 20, "determine" and "process" do not produce a tangible output result.

In claim 27, "determine" and "transition" does not produce a tangible output result.

In claim 28, "assign" does not produce a tangible output result.

In claim 36, "determine" and "transition" do not produce a tangible output result.

In claim 37, "assign" does not produce a tangible output result.

In claim 38 and 39, "determine" and "process" do not produce a tangible output result.

In claim 46, the rejection is similar to claim 36.

In claim 47, "assign" does not produce a tangible output result.

In claim 55, "determine" and "transition" do not produce a tangible output result.

In claim 56, "assign" does not produce a tangible output result.

In claim 57, "determine" and "process" do not produce a tangible output result.

Claims 20-38 are rejected also for non-statutory subject matter, in this case, electromagnetic waves. The specification states in paragraph 0061, last four lines, that a computer-accessible medium may include...signals, such as electogmagnetic ...signals."

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7, 9-16, 18-24, 26, 28-35, 37-43, 45, 47-54, and 56-57 are rejected under 35 U.S.C. 102(b) as being anticipated by McDowell et al henceforth called McDowell.

Claim 1 discloses a method, comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining. (McDowell discloses “the integration of presence determination, location determination, instant messaging...into a functionally seamless system”. P2 of specification, paragraph 0014, lines 2-4. McDowell also discloses several presence states which are not offline in Table 1, P 5 of the specification. “The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts”, thereby selectively processing the instant messaging operation. P4, paragraph 0053, column 2, last three lines.)

Considering claim 2:

Claim 2 discloses the method as recited in claim 1, wherein said instant messaging operation comprises a chat operation. (McDowell discloses the ability for the WAP client to provide instant messaging features such as an “Invitation to chat” on P8 of the specification, paragraph 0099, last two lines.)

Considering claim 3:

Claim 3 discloses the method as recited in claim 1, wherein said instant messaging operation comprises an alert operation. (McDowell discloses that his system can be used for mobile commerce, and commercial message transmission, which can be thought of as an alert operation not requiring any response. P3 of the specification, paragraph 34, lines 5-10)

Considering claim 4:

Claim 4 discloses the method as recited in claim 1, wherein said instant messaging operation comprises a poll operation. (McDowell discloses that his PLIM (Presence Location Instant Messaging) system seeks "interest information" or polls their subscribers for their interests in order to provide commercial message transmission with wireless subscribers. P3 of the specification, paragraph 0041, lines 2-4)

Considering claim 5:

Claim 5 discloses the method as recited in claim 1, wherein selectively processing said instant messaging operation dependent upon said presence state further comprises: notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state. (McDowell discloses idle states such as "On Available" in Table 1 on Page 5 of the specification, which states that the "subscriber is available to be contacted". McDowell also uses a queuing algorithm for the messages to be sent, (Paragraph 0155, last two lines) and also does not try to deliver messages when the user is busy since the user

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can set preferences to receive messages only at certain times of the day and week.

(Table 5, Page 12).

Considering claim 7:

Claim 7 discloses the method as recited in claim 5, further comprising: detecting a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notifying said given user of a queued instant messaging operation in response to detecting said transition.

(McDowell discloses presence determination, or presence detection (Abstract, line 1) which can change from On available (Table 1 P5), an idle user state to Busy or Not Available (Table 1, P5), and the Presence server's method uses a queuing algorithm which sends messages to a user in an instant messaging operation. Paragraph 0155, last two lines).

Considering claim 9:

Claim 9 discloses the method as recited in claim 1, further comprising: storing schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; querying said schedule information; and if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. (McDowell discloses the use of schedule information in Table 5, p 12 where he discloses "Please indicate which time of day you do not wish to

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receive messages. Please indicate which days of the week you do". McDowell also discloses that the "Campaign Manager queries the Presence Server to know if a particular subscriber's phone is on or OFF before attempting to send a targeted mobile commercial message" on P3 of the specification, paragraph 56, lines 7-10. McDowell also discloses that the user can change their current presence state to a different presence state in addition to the schedule information in Tables 1 and 2, page 5 of the specification.)

Considering claim 10:

Claim 10 discloses the method as recited in claim 1, further comprising: storing an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to said given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting.

(McDowell discloses that the Short Message Service Center can "query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts" on P 4, paragraph 0053, last three lines, column 2. It is inherent that the message must have been stored in order to send it later.)

Considering claim 11:

Claim 11 is an independent claim version of claim 10 and is rejected as above.

Considering claim 12:

Claim 12 discloses the method as recited in claim 11, wherein said instant messaging operation comprises a chat operation. (McDowell discloses the ability for the WAP

client to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines.)

Considering claim 13:

Claim 13 discloses the method as recited in claim 12, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said chat operation. (McDowell provides the ability for chatting as mentioned above, with idle user states selected by the user on Page 5, Tables 1 and 2, of the specification)

Considering claim 14:

Claim 14 discloses the method as recited in claim 11, wherein said instant messaging operation comprises an alert operation. (McDowell discloses that his system can be used for mobile commerce, and commercial message transmission, which can be thought of as an alert operation not requiring any response. P3 of the specification, paragraph 34, lines 5-10)

Considering claim 15:

Claim 15 discloses the method as recited in claim 14, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said alert operation. (McDowell discloses idle user states such as "ON Available" in Table 1, P 5 of the specification, and also discloses that alert operations such as commercial message transmission take place on P 3 of the specification, paragraph 34, lines 5-10.)

Considering claim 16:

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Claim 16 discloses the method as recited in claim 11, wherein said instant messaging operation comprises a poll operation. (McDowell discloses that his PLIM (Presence Location Instant Messaging) system seeks "interest information" or polls their subscribers for their interests in order to initiate transactions with wireless subscribers. P3 of the specification, paragraph 0041, lines 2-4)

Considering claim 18:

Claim 18 discloses the method as recited in claim 11, further comprising: storing schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; querying said schedule information; and if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assigning a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. (McDowell discloses that the Short Message Service Center can "query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts" on P 4, paragraph 0053, last three lines, column 2. It is inherent that the message must have been stored in order to send it later. McDowell also discloses the use of schedule information in Table 5, p 12 where he discloses "Please indicate which time of day you do not wish to receive messages. Please indicate which days of the week you do". McDowell also discloses that the user can change their current presence state to a different presence state in addition to the schedule information in Tables 1 and 2, page 5 of the specification.)

Considering claim 19:

Claim 19 discloses the method as recited in claim 11, further comprising: receiving an instant messaging operation directed to said given user, wherein said given user is not offline; determining a presence state of said instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation presence state in response to said determining. dependent upon said presence state in response to said determining. (McDowell discloses his system determines presence states in his instant message system as he discloses that "Presence determination, location determination, instant messaging and mobile commerce are integrated into a functionally seamless system..." on lines 1-3 of the Abstract. McDowell also discloses that he selectively processes the instant messaging operations through the use of his queuing algorithm for the messages to be sent, (Paragraph 0155, last two lines) and also does not try to deliver messages when the user is busy since the user can set preferences to receive messages only at certain times of the day and week. Table 5, Page 12).

Considering claim 20:

Claim 20 discloses a computer-accessible medium comprising program instructions, the program instructions are computer-executable to: wherein receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively

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process said instant messaging operation dependent upon said presence state in response to said determining. (McDowell discloses a Presence Server, IM Server, and Campaign Manager in his PLIM system for performing these functions. McDowell discloses "the integration of presence determination, location determination, instant messaging...into a functionally seamless system". P2 of specification, paragraph 0014, lines 2-4. McDowell also discloses several presence states which are not offline in Table 1, P 5 of the specification. "The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts", thereby selectively processing the instant messaging operation. P4, paragraph 0053, column 2, last three lines.)

Considering claim 21:

Claim 21 discloses the computer-accessible medium as recited in claim 20, wherein said instant messaging operation comprises a chat operation. (McDowell discloses the ability for the WAP client in his instant messaging system to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 22:

Claim 22 discloses the computer-accessible medium as recited in claim 20, wherein said instant messaging operation comprises a chat operation. (McDowell discloses the ability for the WAP client to provide instant messaging features such as an "Invitation to

chat” on P8 of the specification, paragraph 0099, last two lines. McDowell also discloses that the WAP applications are located in the handset, which has embedded software. P4, paragraph 0050, last four lines.)

Considering claim 23:

Claim 23 discloses the computer-accessible medium as recited in claim 20, wherein said instant messaging operation comprises a poll operation. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines. McDowell also discloses that his PLIM (Presence Location Instant Messaging) system seeks “interest information” or polls their subscribers for their interests in order to initiate transactions with wireless subscribers. P3 of the specification, paragraph 0041, lines 2-4)

Considering claim 24:

Claim 24 discloses the computer-accessible medium as recited in claim 20, wherein selectively processing said instant messaging operation dependent upon said presence state further comprises: notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state. (McDowell discloses PLIM hardware on P14, paragraph 0147, last two lines. McDowell also discloses idle states such as “On Available” in Table 1 on Page 5 of the specification, which states that the “subscriber is available to be contacted”. McDowell also uses a queuing algorithm for the messages to be sent,

(Paragraph 0155, last two lines) and also does not try to deliver messages when the user is busy since the user can set preferences to receive messages only at certain times of the day and week. Table 5, Page 12)

Considering claim 26:

Claim 26 discloses the computer-accessible medium as recited in claim 24, wherein said program instructions are further computer-executable to: detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notify said given user of a queued instant messaging operation in response to detecting said transition. (McDowell discloses PLIM hardware which is computer-accessible media on P14, paragraph 0147, last two lines. McDowell also discloses idle states such as "On Available" in Table 1 on Page 5 of the specification, which states that the "subscriber is available to be contacted". McDowell also uses a queuing algorithm for the messages to be sent, (Paragraph 0155, last two lines) and also does not try to deliver messages when the user is busy since the user can set preferences to receive messages only at certain times of the day and week (Table 5, Page 12) or can select "Busy", Table 1 P5.)

Considering claim 28:

Claim 28 discloses the computer-accessible medium as recited in claim 20, wherein said program instructions are further computer-executable to: store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; query said schedule information; and if a current presence state of said instant messenger does not

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correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. . (McDowell discloses the use of schedule information in Table 5, p 12 where he discloses, "Please indicate which time of day you do not wish to receive messages. Please indicate which days of the week you do". McDowell also discloses that the "Campaign Manager queries the Presence Server to know if a particular subscriber's phone is on or OFF before attempting to send a targeted mobile commercial message" on P3 of the specification, paragraph 56, lines 7-10. McDowell also discloses that the user can change their current presence state to a different presence state in addition to the schedule information in Tables 1 and 2, page 5 of the specification.)

Considering claim 29:

Claim 29 discloses the computer-accessible medium as recited program instructions are further computer-executable to: in claim 20, wherein said store an instant messaging operation associated with a given presence state of said instant messenger, wherein said given presence state corresponds to said given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (McDowell discloses that the Short Message Service Center can "query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts" on P 4, paragraph 0053, last three lines,

column 2. It is inherent that the message must have been stored in order to send it later.)

Considering claim 30:

Claim 30 is an independent claim version of claim 29 and is rejected similarly to claim 29.

Considering claim 31:

Claim 31 discloses the computer-accessible medium as recited in claim 30, wherein said instant messaging operation comprises a chat operation. . (McDowell discloses the ability for the WAP client to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines. .

McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 32:

Claim 32 discloses the computer-accessible medium as recited in claim 31, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said chat operation. (McDowell provides the ability for chatting as mentioned above, with idle user states selected by the user on Page 5, Tables 1 and 2, of the specification. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 33:

Claim 33 discloses the computer-accessible medium as recited in claim 30, wherein said instant messaging operation comprises an alert operation. (McDowell discloses that his system can be used for mobile commerce, and commercial message transmission, which can be thought of as an alert operation not requiring any response. P3 of the specification, paragraph 34, lines 5-10. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-accessible media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 34:

Claim 34 discloses the computer-accessible medium as recited in claim 33, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said alert operation. (McDowell discloses idle user states such as "ON Available" in Table 1, P 5 of the specification, and also discloses that alert operations such as commercial message transmission take place on P 3 of the specification, paragraph 34, lines 5-10. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines. McDowell also discloses that his system enables "Merchants should have the ability to initiate promotions, on a permission-oriented basis—just as they do with other media.", referring to commercial message transmission. P1 of specification, paragraph 006, last three lines)

Considering claim 35:

Claim 35 discloses the computer-accessible medium as recited in claim 30, instant messaging operation comprises a poll operation wherein said instant messaging operation comprises a poll operation. . (McDowell discloses that his PLIM (Presence Location Instant Messaging) system seeks "interest information" or polls their subscribers for their interests in order to provide commercial message transmission with wireless subscribers. P3 of the specification, paragraph 0041, lines 2-4. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 37:

Claim 37 discloses the computer-accessible medium as recited in claim 30, wherein said program instructions are further computer-executable to: store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; query said schedule information; and if a current presence state of said instant messenger does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. (McDowell discloses the use of schedule information in Table 5, p 12 where he discloses, "Please indicate which time of day you do not wish to receive messages. Please indicate which days of the week you do". McDowell also

discloses that the "Campaign Manager queries the Presence Server to know if a particular subscriber's phone is on or OFF before attempting to send a targeted mobile commercial message" on P3 of the specification, paragraph 56, lines 7-10. McDowell also discloses that the user can change their current presence state to a different presence state in addition to the schedule information in Tables 1 and 2, page 5 of the specification. McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 38:

Claim 38 discloses the computer-accessible medium as recited in claim 30, wherein said program instructions are further computer-executable to: receive an instant messaging operation directed to said given user, wherein said given user is not offline; determine a presence state of said instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (McDowell discloses "the integration of presence determination, location determination, instant messaging...into a functionally seamless system". P2 of specification, paragraph 0014, lines 2-4. McDowell also discloses several presence states which are not offline in Table 1, P 5 of the specification. "The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts", thereby selectively processing the instant messaging operation. P4, paragraph 0053, column 2, last three lines.

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McDowell also discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 39:

Claim 39 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (McDowell discloses that his PLIM system hardware that performs all these functions and inherently includes computer-readable media in order to function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines. McDowell also discloses an IM server or Instant Messaging Server, which is a software module executing on a computer system. McDowell discloses "the integration of presence determination, location determination, instant messaging...into a functionally seamless system". P2 of specification, paragraph 0014, lines 2-4. McDowell also discloses several presence states which are not offline in Table 1, P 5 of the specification. "The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts", thereby selectively processing the instant messaging

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operation. P4, paragraph 0053, column 2, last three lines. McDowell discloses that "conceptually, the Presence Server 112, the Location Proxy Server 114, the IM Server 116, and the Campaign Manager 118 may be implemented as software modules that may execute on separate physical machines, or on a single physical machine, at a common location, or remotely from one another, depending on operational convenience." Paragraph 0048, P4 of the specification, lines 3-9.)

Considering claim 40:

Claim 40 discloses the system as recited in claim 39, wherein said instant messaging operation comprises a chat operation. (McDowell discloses the ability for the WAP client to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines.)

Considering claim 41:

Claim 41 discloses the system as recited in claim 39, wherein said instant messaging operation comprises an alert operation. (McDowell discloses that his system can be used for mobile commerce, and commercial message transmission, which can be thought of as an alert operation not requiring any response. P3 of the specification, paragraph 34, lines 5-10.)

Considering claim 42:

Claim 42 discloses the system as recited in claim 39, wherein said instant messaging operation comprises a poll operation. (McDowell discloses that his PLIM (Presence Location Instant Messaging) system seeks "interest information" or polls their

subscribers for their interests in order to provide commercial message transmission with wireless subscribers. P3 of the specification, paragraph 0041, lines 2-4.)

Considering claim 43:

Claim 43 discloses the system as recited in claim 39, wherein selectively processing said instant messaging operation dependent upon said presence state further comprises: notifying said given user of said instant messaging operation if said presence state is indicative of an idle user state; and queuing said instant messaging operation without notifying said given user if said presence state is indicative of a busy user state. (McDowell discloses PLIM hardware on P14, paragraph 0147, last two lines. McDowell also discloses idle states such as "On Available" in Table 1 on Page 5 of the specification, which states that the "subscriber is available to be contacted". McDowell also uses a queuing algorithm for the messages to be sent, (Paragraph 0155, last two lines) and also does not try to deliver messages when the user is busy since the user can set preferences to receive messages only at certain times of the day and week (Table 5, Page 12) or can select "Busy", Table 1 P5.)

Considering claim 45:

Claim 45 discloses the system as recited in claim 43, wherein said instant messenger software module is further configured to: detect a transition from a presence state indicative of a busy user state to a presence state indicative of an idle user state subsequent to said queuing; and notify said given user of a queued instant messaging operation in response to detecting said transition. (McDowell discloses presence determination, or presence detection (Abstract, line 1) which can change from On

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available (Table 1 P5), an idle user state to Busy or Not Available (Table 1, P5), and the Presence server's method uses a queuing algorithm which sends messages to a user in an instant messaging operation. Paragraph 0155, last two lines).

Considering claim 47:

Claim 47 discloses the system as recited in claim 39, wherein said instant messenger software module is further configured to: store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; query said schedule information; and if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. (McDowell discloses the use of schedule information in Table 5, p 12 where he discloses, "Please indicate which time of day you do not wish to receive messages. Please indicate which days of the week you do". McDowell also discloses that the "Campaign Manager queries the Presence Server to know if a particular subscriber's phone is on or OFF before attempting to send a targeted mobile commercial message" on P3 of the specification, paragraph 56, lines 7-10. McDowell also discloses that the user can change their current presence state to a different presence state in addition to the schedule information in Tables 1 and 2, page 5 of the specification. McDowell also discloses that his PLIM system hardware that performs all these functions in order to

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function is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 48:

Claim 48 discloses the system as recited in claim 39, wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to said given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (McDowell discloses that the Short Message Service Center can "query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts" on P 4, paragraph 0053, last three lines, column 2. It is inherent that the message must have been stored in order to send it later.)

Considering claim 49:

Claim 49 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to Said detecting. . (McDowell discloses that his PLIM system hardware that performs all these functions is located in a well

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protected, trusted facility on P14, paragraph 0147, last two lines. McDowell also discloses an IM server or Instant Messaging Server, which is a software module executing on a computer system. McDowell discloses "the integration of presence determination, location determination, instant messaging...into a functionally seamless system". P2 of specification, paragraph 0014, lines 2-4. McDowell also discloses several presence states which are not offline in Table 1, P 5 of the specification. "The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts", thereby selectively processing the instant messaging operation. P4, paragraph 0053, column 2, last three lines. McDowell discloses that "conceptually, the Presence Server 112, the Location Proxy Server 114, the IM Server 116, and the Campaign Manager 118 may be implemented as software modules that may execute on separate physical machines, or on a single physical machine, at a common location, or remotely from one another, depending on operational convenience." Paragraph 0048, P4 of the specification, lines 3-9.) McDowell discloses that the Short Message Service Center can "query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts" on P 4, paragraph 0053, last three lines, column 2. It is inherent that the message must have been stored in order to send it later.)

Considering claim 50:

Claim 50 discloses the system as recited in claim 49, wherein said instant messaging operation comprises a chat operation. (McDowell discloses the ability for the WAP client

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to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines)

Considering claim 51:

Claim 51 discloses the system as recited in claim 50, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said chat operation. (McDowell discloses the ability for the WAP client to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines. McDowell also discloses idle user states selected by the user such as ON available on Page 5, Tables 1 and 2, of the specification)

Considering claim 52:

Claim 52 discloses the system as recited in claim 49, wherein said instant messaging operation comprises an alert operation. (McDowell discloses that his system can be used for mobile commerce, and commercial message transmission, which can be thought of as an alert operation not requiring any response. P3 of the specification, paragraph 34, lines 5-10.)

Considering claim 53:

Claim 53 discloses the system as recited in claim 52, wherein said given presence state is indicative of an idle user state, and wherein performing said instant messaging operation comprises initiating said alert operation. (McDowell discloses idle user states such as "ON Available" in Table 1, P 5 of the specification, and also discloses that alert operations such as commercial message transmission take place on P 3 of the

specification, paragraph 34, lines 5-10. McDowell also discloses that his system enables "Merchants should have the ability to initiate promotions, on a permission-oriented basis—just as they do with other media.", referring to commercial message transmission. P1 of specification, paragraph 006, last three lines.)

Considering claim 54:

Claim 54 discloses the system as recited in claim 49, wherein said instant messaging operation comprises a poll operation. (McDowell discloses that his PLIM (Presence Location Instant Messaging) system seeks "interest information" or polls their subscribers for their interests in order to provide commercial message transmission with wireless subscribers. P3 of the specification, paragraph 0041, lines 2-4.)

Considering claim 56:

Claim 56 discloses the system as recited in claim 49, wherein said instant messenger software module is further configured to: store schedule information corresponding to said given user, wherein said schedule information is indicative of an activity status of said given user at a given time; query said schedule information; and if a current presence state of said instant messenger software module does not correspond to said activity status indicated by said schedule information, assign a different presence state that corresponds to said activity status in response to said querying, wherein said current presence state and said different presence state each correspond to said given user. (McDowell discloses the use of schedule information in Table 5, p 12 where he discloses, "Please indicate which time of day you do not wish to receive messages. Please indicate which days of the week you do". McDowell also discloses that the

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"Campaign Manager queries the Presence Server to know if a particular subscriber's phone is on or OFF before attempting to send a targeted mobile commercial message" on P3 of the specification, paragraph 56, lines 7-10. McDowell also discloses that the user can change their current presence state to a different presence state in addition to the schedule information in Tables 1 and 2, page 5 of the specification. McDowell also discloses that his PLIM system hardware that performs all these functions is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

Considering claim 57:

Claim 57 discloses the system as recited in claim 49, wherein said instant messenger software module is further configured to: receive an instant messaging operation directed to said given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (McDowell discloses "the integration of presence determination, location determination, instant messaging...into a functionally seamless system". P2 of specification, paragraph 0014, lines 2-4. McDowell also discloses several presence states which are not offline in Table 1, P 5 of the specification. "The SMSC 134 can query the Presence Server 112 before attempting to send a message, eliminating inefficient retry attempts", thereby selectively processing the instant messaging operation. P4, paragraph 0053, column 2, last three lines. McDowell also

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discloses that his PLIM system hardware that performs all these functions is located in a well protected, trusted facility on P14, paragraph 0147, last two lines)

7. Claims 1, 8, 11, 17, 20, 27, 30, 36, 39, 46, 49, and 55 are rejected under 35 U.S.C. 102(b) as being anticipated by Aravamudan et al, henceforth called Aravamudan, (US patent number 6301609 B1, dated October 9, 2001.)

Considering claim 1:

Claim 1 discloses a method, comprising: receiving an instant messaging operation directed to a given user, wherein said given user is not offline; determining a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively processing said instant messaging operation dependent upon said presence state in response to said determining. (Aravamudan discloses instant messaging with presence detection in column 7, "The IM server also notifies selected buddies to the user of the users presence online.", lines 15-16. Aravamudan also discloses that messages are selectively processed since "Associates assigned the highest priority by the user, are able to interface with the user directly when the user is online..." column 2, paragraph 2, last three of four lines.)

Considering claim 8:

Claim 8 discloses the method as recited in claim 1, further comprising: detecting a computer system activity level indicative of computer system activity; determining whether said activity level exceeds an activity threshold in response to said detecting;

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and transitioning said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

(Aravamudan discloses computer system activity and detection which leads to an "active state" or busy state such as keyboard activity, with time limit thresholds for the activity and is disclosed in column 7, paragraph 3, entire paragraph.)

Considering claim 11:

Claim 11 discloses a method, comprising: storing an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user; detecting a transition to said given presence state subsequent to said storing; and performing said instant messaging operation in response to said detecting. (Aravamudan discloses instant messaging with presence detection in column 7, "The IM server also notifies selected buddies to the user of the users presence online.", lines 15-16. Aravamudan also discloses that the instant messaging operations are stored and then performed since "If the user is located, determined by the users response to a CSP query, then the user is notified that an important event has been received and the CSP initiates an instant message to elicit the user's instructions for delivery of the content of important event. In the alternative, the first rule set may direct the CSP to hold the important event in abeyance..." "An important events include any data, communication, or notification received for the user...", stated in column 8, paragraph 2, lines 6-7 implying that an important event can be an instant messaging operation.)

Considering claim 17:

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Claim 17 discloses the method as recited in claim 11, further comprising: detecting a computer system activity level indicative of computer system activity; determining whether said activity level exceeds an activity threshold in response to said detecting; and transitioning said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold.

(Aravamudan discloses computer system activity and detection which leads to an "active state" or busy state, such as keyboard activity, with time limit thresholds for the activity, and is disclosed in column 7, paragraph 3, entire paragraph.)

Considering claim 20:

Claim 20 discloses a computer-accessible medium comprising program instructions, the program instructions are computer-executable to: wherein receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of an instant messenger in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Aravamudan discloses instant messaging with presence detection in column 7, "The IM server also notifies selected buddies to the user of the users presence online.", lines 15-16. Aravamudan also discloses that messages are selectively processed since "Associates assigned the highest priority by the user, are able to interface with the user directly when the user is online..." column 2, paragraph 2, last three of four lines. The computer-accessible mediums including ROM, RAM, and

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other hardware for storing the software to do this is disclosed in column 12, second paragraph in its entirety.)

Considering claim 27:

Claim 27 discloses the computer-accessible medium as recited in claim 20, wherein said program instructions are further computer-executable to: detect a computer system activity level indicative of computer system activity; determine whether said activity level exceeds an activity threshold in response to said detecting; and transition said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold. (Aravamudan discloses computer system activity and detection which leads to an "active state" or busy state, such as keyboard activity, with time limit thresholds for the activity and is disclosed in column 7, paragraph 3, entire paragraph.)

Considering claim 30:

Claim 30 discloses a computer-accessible medium comprising program instructions, wherein the program instructions are computer-executable to: store an instant messaging operation associated with a given presence state of an instant messenger, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (Aravamudan discloses instant messaging with presence detection in column 7, "The IM server also notifies selected buddies to the user of the users presence online.", lines 15-16. Moncreiff also discloses that the instant messaging operations are stored and then performed since "If

the user is located, determined by the users response to a CSP query, then the user is notified that an important event has been received and the CSP initiates an instant message to elicit the user's instructions for delivery of the content of important event. In the alternative, the first rule set may direct the CSP to hold the important event in abeyance..." "An important events include any data, communication, or notification received for the user...", stated in column 8, paragraph 2, lines 6-7 implying that an important event can be an instant messaging operation. Aravamudan also discloses the computer-accessible mediums including ROM, RAM, and other hardware for storing the software to do this is disclosed in column 12, second paragraph in its entirety.)

Considering claim 36:

Claim 36 discloses the computer-accessible medium as recited in claim 30, wherein said program instructions are further computer-executable to: detect a computer system activity level indicative of computer system activity; determine whether said activity level exceeds an activity threshold in response to said detecting; and transition said presence state of said instant messenger to a busy state in response to determining that said activity level exceeds said activity threshold. (Aravamudan discloses computer system activity and detection which leads to an "active state" or busy state, such as keyboard activity, with time limit thresholds for the activity and is disclosed in column 7, paragraph 3, entire paragraph.)

Considering claim 39:

Claim 39 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant

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messenger software module is further configured to: receive an instant messaging operation directed to a given user, wherein said given user is not offline; determine a presence state of said instant messenger software module in response to receiving said instant messaging operation, wherein said presence state corresponds to said given user; and selectively process said instant messaging operation dependent upon said presence state in response to said determining. (Aravamudan discloses instant messaging with presence detection in column 7, "The IM server also notifies selected buddies to the user of the users presence online.", lines 15-16. Aravamudan also discloses that messages are selectively processed since "Associates assigned the highest priority by the user, are able to interface with the user directly when the user is online..." column 2, paragraph 2, last three of four lines. Aravamudan also discloses the instant messaging software module as "an instant messaging system as a personal communication services platform" in column 2, paragraph 2, lines 8-9. Aravamudan also discloses the computer system as "hardware capable of executing software in association with appropriate software" in column 12, paragraph 2, lines 4-5.)

Considering claim 46:

Claim 46 discloses the system as recited in claim 39, wherein said instant messenger software module is further configured to: detect a computer system activity level indicative of computer system activity; determine whether said activity level exceeds an activity threshold in response to said detecting; and transition said presence state of said instant messenger software module to a busy state in response to determining that said activity level exceeds said activity threshold. (Aravamudan discloses computer

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system activity, such as keyboard activity, with time limit thresholds for the activity and detection which leads to an "active state" or busy state and is disclosed in column 7, paragraph 3, entire paragraph.)

Considering claim 49:

Claim 49 discloses a system, comprising: a computer system; an instant messenger software module configured to execute on said computer system; wherein said instant messenger software module is further configured to: store an instant messaging operation associated with a given presence state of said instant messenger software module, wherein said given presence state corresponds to a given user; detect a transition to said given presence state subsequent to said storing; and perform said instant messaging operation in response to said detecting. (Aravamudan discloses the instant messaging software module as "an instant messaging system as a personal communication services platform" in column 2, paragraph 2, lines 8-9. Moncreiff also discloses the computer system as "hardware capable of executing software in association with appropriate software" in column 12, paragraph 2, lines 4-5.

Aravamudan discloses instant messaging with presence detection in column 7, "The IM server also notifies selected buddies to the user of the users presence online.", lines 15-16. Aravamudan also discloses that the instant messaging operations are stored and then performed since "If the user is located, determined by the users response to a CSP query, then the user is notified that an important event has been received and the CSP initiates an instant message to elicit the user's instructions for delivery of the content of important event. In the alternative, the first rule set may direct the CSP to

hold the important event in abeyance..." "An important events include any data, communication, or notification received for the user...", stated in column 8, paragraph 2, lines 6-7 implying that an important event can be an instant messaging operation.)

Considering claim 55:

Claim 55 discloses the system as recited in claim 49, wherein said instant messenger software module is further configured to: detect a computer system activity level indicative of computer system activity; determine whether said activity level exceeds an activity threshold in response to said detecting; and transition said presence state of said instant messenger software module to a busy state in response to determining that said activity level exceeds said activity threshold. (Aravamudan discloses computer system activity, such as keyboard activity, with time limit thresholds for the activity, and detection, which leads to an "active state" or busy state and is disclosed in column 7, paragraph 3, entire paragraph.)

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 6, 25, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over McDowell (US Publication number 2002/0035605, dated March 21, 2002) and

further in view of Generous et al, henceforth called Generous (US Publication number US2002/0120697 A1, dated August 29, 2002)

Considering claim 6:

Claim 6 discloses the method as recited in claim 5, wherein said instant messaging operation is a chat operation initiated by a second user, and wherein queuing said instant messaging operation without notifying said given user further comprises notifying said second user of said queuing. McDowell discloses the ability for the WAP client to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines, and allows for "buddy lists" disclosed in paragraph 0039 on page 3 of the specification which implies that chat operations can be initiated by a second user. McDowell discloses all the limitations as described above except for notifying the user of queuing the instant messaging operation.

Generous discloses that "the system of the invention provides for the ability to gather real time statistics on the actions of delivery, reading, bouncing, forwarding, in-transit, queued and replies. The status of each message is tracked so that clients may query for the status of messages and for summary reporting of submissions. The system should be able to trace message assembly, queuing, delivery and failures, to remote destinations, independently of the communication channel used." paragraph 0035, first three lines. The general concept of providing a queuing notification system is well known in the art as illustrated by Generous which discloses queuing of messages and notifying the client of queuing in a message system.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify McDowell of his instant message system in his advantageous method as taught by Generous in order to improve "delivery of information, such as a message...in a manner that increases the likelihood of receipt by the recipient" as stated by Generous on P1 of the specification, paragraph 0004, last three lines.

Considering claim 25:

Claim 25 discloses the computer-accessible medium as recited in claim 24, wherein said instant messaging operation is a chat operation initiated by a second user, and wherein queuing said instant messaging operation without notifying said given user further comprises notifying said second user of said queuing. McDowell discloses PLIM hardware which is computer-accessible media on P14, paragraph 0147, last two lines, with the ability for the WAP client to provide instant messaging features such as an "Invitation to chat" on P8 of the specification, paragraph 0099, last two lines, and allows for "buddy lists" disclosed in paragraph 0039 on page 3 of the specification which implies that chat operations can be initiated by a second user. McDowell discloses all the limitations as described above except for notifying the user of queuing the instant messaging operation.

Generous discloses that "the system of the invention provides for the ability to gather real time statistics on the actions of delivery, reading, bouncing, forwarding, in-transit, queued and replies. The status of each message is tracked so that clients may query for the status of messages and for summary reporting of submissions. The system should be able to trace message assembly, queuing, delivery and failures, to

remote destinations, independently of the communication channel used.” paragraph 0035, first three lines. The general concept of providing a queuing notification system is well known in the art as illustrated by Generous which discloses queuing of messages and notifying the client of queuing in a message system.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify McDowell of his instant message system in his advantageous method as taught by Generous in order to improve “delivery of information, such as a message...in a manner that increases the likelihood of receipt by the recipient” as stated by Generous on P1 of the specification, paragraph 0004, last three lines.

Considering claim 44:

Claim 44 discloses the system as recited in claim 43, wherein said instant messaging operation is a chat operation initiated by a second user, and wherein queuing said instant messaging operation without notifying said given user further comprises notifying said second user of said queuing. McDowell discloses PLIM system hardware on P14, paragraph 0147, last two lines, with the ability for the WAP client to provide instant messaging features such as an “Invitation to chat” on P8 of the specification, paragraph 0099, last two lines, and allows for “buddy lists” disclosed in paragraph 0039 on page 3 of the specification which implies that chat operations can be initiated by a second user. McDowell discloses all the limitations as described above except for notifying the user of queuing the instant messaging operation.

Generous discloses that “the system of the invention provides for the ability to gather real time statistics on the actions of delivery, reading, bouncing, forwarding, in-

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transit, queued and replies. The status of each message is tracked so that clients may query for the status of messages and for summary reporting of submissions. The system should be able to trace message assembly, queuing, delivery and failures, to remote destinations, independently of the communication channel used.” paragraph 0035, first three lines. The general concept of providing a queuing notification system is well known in the art as illustrated by Generous which discloses queuing of messages and notifying the client of queuing in a message system.

It would have been obvious for one of ordinary skill in the art at the time of the invention to modify McDowell of his instant message system in his advantageous method as taught by Generous in order to improve “delivery of information, such as a message...in a manner that increases the likelihood of receipt by the recipient” as stated by Generous on P1 of the specification, paragraph 0004, last three lines.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joan B. Naurot Ton whose telephone number is 571-270-1595. The examiner can normally be reached on M-Th 9 to 6:30 (flex sched) and alt Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on 571-272-6681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBNT
1/18/2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER

A handwritten signature in black ink, appearing to read 'Frantz', with a large, sweeping horizontal stroke underneath.

